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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,954	02/25/2004	Lyle D. Tincknell	ITT-538-A	3790
22825	7590	08/11/2006	EXAMINER	
WILLIAM M HANLON, JR YOUNG & BASILE, PC 3001 WEST BIG BEAVER ROAD SUITE 624 TROY, MI 48084-3107			BOCHNA, DAVID	
			ART UNIT	PAPER NUMBER
			3679	
DATE MAILED: 08/11/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/786,954	TINCKNELL ET AL.
	Examiner	Art Unit
	David E. Bochna	3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 May 2006.
- 2a) This action is FINAL.                                   2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 3-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3 and 6-22 is/are rejected.
- 7) Claim(s) 5 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Allowable Subject Matter***

1. The indicated allowability of claim 19 is withdrawn in view of the newly discovered reference(s) to Benda et al. Rejections based on the newly cited reference(s) follow.
2. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Information Disclosure Statement***

3. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the

requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

***Claim Objections***

4. Claim 22 is objected to because of the following informalities: Claim 22 was not included in the list of amended claims submitted on 5/15/06. Appropriate correction is required.
5. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 19-21 have been renumbered 20-22.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6, line 6, it is unclear how there can be "a second durometer" being claimed when a first durmeter has not yet been recited in the claim.

Claim 6, line 13, it is unclear which "portion" is being referred to, the first portion or second portion.

Claim 6, line 14, it is unclear how the phrase "rim of the second portion" came to refer to

the second portion and not the first portion because claim 6 as filed on 1/6/06 recited the phrase “rim of the first portion”.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3-4, 11-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Benda et al.

In regard to claim 1, Benda et al. discloses a drain seal (“for use with a drain tube in a structure having any aperture” is an intended use limitation), the drain seal comprising:

a unitary body having first and second double shot moldingly joined portions (see col. 4, lines 25-35);

the first portion 52 formed of a material having a first durometer and the second portion 48 formed of a material having a second durometer; and

a bore 50 extending through the body from one end of the first portion of the body to an opposite end of the second portion of the body.

In regard to claim 3, wherein the joint comprises:

at least one enlargement 54 formed on the first portion.

In regard to claim 4, wherein the at least one enlargement 54 has an outer diameter larger than an inner diameter of a drain tube.

In regard to claim 11, the first durometer material with a higher durometer than the second durometer.

In regard to claim 12, an extension 62 formed centrally on the first portion;

The second portion 7 surrounding and receiving the extension 6 of the first portion.

In regard to claim 13, Benda et al. discloses a method for forming a drain seal for use with a drain tube and a structure having an aperture, the method comprising the steps of:

molding a unitary body of first 52 and second 62 moldingly joined portions;

forming the first portion of a material having a first durometer;

forming the second portion of a material having a second durometer;

and

forming a bore 50 extending through the body from one end of the first portion to an opposite end of the second portion.

In regard to claim 14, forming the first durometer material with a higher durometer than the second durometer.

In regard to claim 15, further forming a joint 62 on the first portion of the body adapted for sealingly joining the body to a drain tube.

In regard to claim 16, further forming a mount 48 on the second portion of the body adapted for mounting the body in an aperture in a structure.

In regard to claim 17, forming an annular undercut 84 between the drain end of the second portion of the body and an end surface of the body.

In regard to claim 18, further comprising the steps of forming enlarged ends 66, 65 for the first and second portions; and moldingly joining the enlarged ends.

In regard to claim 19, Benda et al. discloses a method for forming a drain seal for use with a drain tube and a structure having an aperture, the method comprising the steps of:

Double shot molding the first and second portions into a unitary body (fig. 4) (see col. 4, lines 25-35);

Forming the first portion 54 of a material having a first durometer;

Forming the second portion 48 of a material having a second durometer; and

Forming a bore 50 extending through the body from one end of the first portion to an opposite end of the second portion.

In regard to claim 20, further comprising a joint 62 carried on the first portion adapted for sealingly joining the body to a drain tube.

In regard to claim 21, a mount 66 (see fig. 8) carried on the second portion adapted for mounting the body in an aperture in a structure.

In regard to claim 22, Benda et al. discloses a drain seal comprising:

A unitary body of first 52 and second 48, moldingly joined portions;

The first portion 52 formed of a material having a first durometer;

The second portion 62 formed of a material having a second durometer; and

A bore 50 extending through the body from one end of the first portion to an opposite end of the second portion.

#### *Response to Arguments*

10. Applicant's arguments with respect to claims 1, 3-4 and 11-22 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Bochna whose telephone number is (571) 272-7078.

The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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